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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,828	10/10/2000	Teresa Farias Latter	8285/397	6942
757	7590	08/29/2006	EXAMINER GAUTHIER, GERALD	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			ART UNIT 2614	PAPER NUMBER

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,828

Applicant(s)

LATTER ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claim(s) 11-13, 15, 17-21, 24 and 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier (US 5,850,435) in view of Crockett et al. (US 6,633,634 B1).

Summary

Devillier discloses a method for providing audible caller identification. The method steps of Fig.1 outside the dashed box are common to all embodiments of Devillier. The method of Fig. 3 illustrates a different embodiment that replaces the dashed box embodiment of Fig.1. The embodiment illustrated by Fig.3 will be relied upon in this office action.

With respect to **claim(s) 11**, see the following paragraphs for details on how Devillier anticipates particular limitations within the claim.

“(a) determining whether standard caller identification information for the calling communication station can be provided to the called communication station by analyzing data contained within a query” reads on Devillier as follows. The system determines whether the caller's name (standard caller identification) can be provided by querying a line information database (Fig. 3, step 301 and col. line 65 col. 14). The database “query” contains “data” in the form of the caller's number.

The caller's number (data within the query) is analyzed in order to determine whether the caller's name (standard caller identification information) can be retrieved from the database and provided to the called station.

Therefore, the system analyzes data (caller's number) contained within the query to determine whether the standard caller identification information (caller's name) can be provided.

"b) transmitting a request for audible caller identification information to the calling communication station in response to a determination that the standard caller identification information cannot be provided to the called communication station" clearly reads on Fig. 3 steps 303, 305, and col. 4, lines 7-8.

"(c) transmitting the audible caller identification information to the called communication station if the calling party provides audible caller identification information" clearly reads on Fig. 1, step 117 and col. 3, lines 21-22.

Devillier fails to disclose wherein the data includes an indication of whether or not there is a restriction on the presentation of the standard caller identification.

However, Crockett teaches wherein the data includes an indication of whether or not there is a restriction on the presentation of the standard caller identification (column 8, lines 43-62).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Devillier using the teaching of the caller identification as taught by Crockett.

This modification of the invention enables the system to determine the data includes an indication of whether or not there is a restriction on the presentation of the standard caller identification so that the user would hear the selected message at the called station.

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Claim(s) 24 differs substantively from **claim(s) 11** in that **claim(s) 24** recites the following additional limitations. "(c) receiving audible caller identification information from the calling party" clearly reads on Fig. 1, step 111. "(d) causing the called communication station to ring" reads on Fig. 1, steps 115 and col. 3, lines 13-21 where the system causes a call to be placed to a telephone. The ring can be in the form of a conventional ring or audible caller name announcement (col. 3, lines 33-36).

With respect to **claim(s) 12 and 13**, see col. 4, lines 5-8 where a null or invalid calling name would be an unavailable or incomplete.

With respect to **claim(s) 15**, see line 65 - col. Line Fig .1, step 109 and col.

With respect to **claim(s) 17**, see Fig. steps 111 and 117.

With respect to **claim(s) 18, 19, 26, and 27**, see Fig. step 119.

With respect to **claim(s) 20**, see col. lines 37-40.

With respect to **claim(s) 21 and 28**, see Fig .1, step (121).

Claim(s) 14, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier in view of Crockett as applied to **claim(s) 11 and 24** above, and further in view of Blumhardt (US 5,533,106).

With respect to **claim(s) 14**, although Devillier in combination with Crockett disclose the step of determining if a null or otherwise invalid caller identification is detected (col. 4, lines 5-8), Devillier does not specifically disclose determining caller identification has been blocked.

However, Blumhardt also teaches of a caller identification method (Fig. 5) that includes the step of determining the caller identification has been blocked (col. 3, lines 9-15).

Therefore, it would have been obvious to a person of in the art at the time the invention was made to ordinary skill add the step of determining whether caller identification has been blocked as taught by Blumhardt to the audible caller identification system disclosed by Devillier.

The suggestion/motivation for doing so would have been to increase the user-friendliness of a caller identification system by reducing the readily known ability of the most undesirable callers to select the "privacy" option and block the transmission of their DN that would in many cases defeat the objectives of caller identification (Blumhardt, col. 2, lines 14-32).

With respect to **claim(s) 16 and 25**, Devillier in combination with Crockett disclose that step of repeatedly transmitting a request for the calling party to speak his name (Fig. 3, step 305) until a valid name is received or until a system error limit is reached such as three attempts (Fig. 1, step 113 and col. lines 5-13).

Devillier does not expressly disclose that message indicates that the called station does not accept calls from an unidentified calling party.

However, Blumhardt also teaches of a caller identification method (Fig. 5) that includes the step of indicating that the called station does not accept calls from an unidentified calling party (play announcement for caller... "to be connected to your party, you must allow your 'calling party ID' to be displayed'...").

Therefore, would have been obvious to a person of in the art at the time the invention was made to ordinary skill add the step of indicating that the called station does not accept calls from an unidentified calling party as taught by caller identification method of Blumhardt to the caller identification method disclosed by Devillier.

The suggestion/motivation for doing so would have been to increase the user-friendliness and versatility of the caller identification system by making it clear to the caller that identification is required. This much is suggested in Devillier by the repeated prompting of the caller to enter an identification until a valid identification is received or until a system error limit is reached (e.g., three attempts) as discussed above. Further, indicating that identification is required upfront by a single, express statement, as taught by Blumhardt, instead of indicating that identification is required by repeatedly

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prompting the caller (e.g., three attempts) would have increased efficiency by simply avoiding the need for repeated, time-consuming and resource consuming prompting.

Finally, the particular indications that the prompt disclosed by Devillier actually provide to the caller reads on message content, and as such, does not require Devillier to be substantially modified in a structural sense. The claimed invention should result in a significant structural difference over the prior art in order to patentably distinguish the claimed invention from the prior art. In this way, owners of the patented prior art devices are protected when using their devices as they see fit.

Claim(s) 22 and 29 being are rejected under 35 U.S.C. 103(a) as unpatentable over Devillier in view of Crockett as applied to **claim(s) 11 and 24** above, and further in view of Newton (Harry Newton, Newton's Telecom Dictionary, 8th Ed ISBN 0-936648-60-0).

Devillier in combination with Crockett disclose that the calling communication telephone may be connected to the called communication telephone in response to the called station "pressing 1" (col. 3, lines 37-42), Devillier does not disclose that the "1" corresponds to a DTMF button.

Newton teaches that telephones contain DTMF signaling buttons (i.e. touchtone) (page 1051, "Touchtone").

Therefore, would have been obvious to a person of in the art at the time the invention was made to ordinary skill add DTMF signaling buttons as taught by Newton to the method using a called telephone disclosed by Devillier.

The suggestion/motivation for doing so would have been to conform to industry standards since touchtone telephones are extremely well known and common.

Claim(s) 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier in view of Crockett as applied to **claim(s) 11 and 24** above, and further in view Serbetcioglu et al. (US 5,511,111).

Devillier does not disclose the step of canceling the call in response to the called communication station being placed on-hook.

However, Serbetcioglu also teaches of an audible caller identification method (Figs. 2A and 2B) where the call is cancelled if it is detected that the called communication station was placed on-hook (Fig. 2C, step 250). See also col. lines 41-45.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the step of canceling the call in response to the called communication station being placed on-hook as taught by Serbetcioglu to the audible caller identification method by Devillier.

The suggestion/motivation for doing so would have been to conform to industry standards of canceling a service if the called party (subscriber) goes on-hook, or in other words, hangs up. Not canceling service delivery to the subscriber after the subscriber hangs up could be extremely inconvenient and irritating to the subscriber. Finally, since both Devillier and Serbetcioglu are specifically directed to audible caller identification systems, the designer of an audible caller identification system would be

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aware of the concept and advantages of canceling service would be reasonable to conclude that delivery if the called party (subscriber) hangs up.

Response to Arguments

5. Applicant's arguments with respect to **claim(s) 11-30** have been considered but are moot in view of the new ground(s) of rejection.

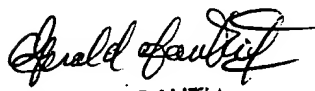
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

Gerald Gauthier
Examiner
Art Unit 2614

GG
August 28, 2006